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EXAMINER

ABEL JALIL, NEVEEN

ART UNIT PAPER NUMBER

2165

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/990,359

Applicant(s)

MOSTAFA, MIRAJ

Examiner

Neveen Abel-Jalil

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 18-August-2005 has been entered.

2. The amendment filed on 18-August-2005 has been received and entered. Claims 14-18 are newly added. Therefore, claims 1-18 are now pending.

### ***Claim Objections***

3. Claims 5-6, and 14 are objected to because of the following informalities:

In claim 5, line 2, the recitation of "can be" is indirect and passive which renders any recitation claimed after not be given patentable weight. Appropriate correction is required.

Claim 6 dependent on claim 5 and therefore carry the same deficiency.

In claim 14, line 2, the recitation of "can be" is indirect and passive which renders any recitation claimed after not be given patentable weight. Appropriate correction is required.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-18 are provisionally rejected under the judicially created doctrine of double patenting over claims 17, 40, 42, and 43 of copending application Serial No. 10/149,639 and as that of claim 21 of copending application Serial No. 09/920,910. This is a *provisional* double patenting rejection since the conflicting claims have not in fact been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter.

*Claim Rejections - 35 USC § 112*

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 18 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant's specification does not explicitly prohibit requiring ongoing accessing of the media content by the addressed recipient.

The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. See MPEP 2173.05(i).

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 6, 7, 10, 15, and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites the limitations "said providing" in line 2. There is insufficient antecedent basis for this limitation in the claim.

The term " a minimum amount of information necessary" in claim 7, line 2 is a relative term which renders the claim indefinite. The term " a minimum amount of information necessary " is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim 10 recites the limitations "the properties" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 15 recites the limitations "the network's multimedia capabilities, the network's traffic condition, and the availability of processing resources in that network" in lines 3 & 4. There is insufficient antecedent basis for this limitation in the claim.

In claim 16, line 2, the recitation of "the same" is vague and indefinite. It is confusing and unclear to the Examiner what is meant by "the same" and therefore renders the claim indefinite.

***Claim Rejections - 35 USC § 102***

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10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Luzeski et al. (U.S. Patent No. 6,430,177 B1).

As to claims 1, 11, 12, and 13, Luzeski et al. discloses a method in a network entity, a computer program for controlling a network entity stored therein, the program when executed causing the network to perform, a communication system, comprising:

at least one recipient (lines 28-34 of column 15 designates the message destined for multiple recipients and lines 54-55 of column 16);

a network entity (abstract);

receiving media content from a sending entity and addressed to at least one recipient (lines 28-34 of column 15 designates the message destined for multiple recipients and lines 54-55 of column 16);

accessing a database comprising recipient data describing multimedia reception capabilities and/or reception preferences for at least one recipient (See column 13, lines 18-33, also see column 14, lines 6-12);

forming, in accordance with said recipient data, a notification message (lines 7-29 of column 20) containing information that said media content is available to be streamed to said at

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least one addressed recipient (lines 49-54 of column 20, line 66 of column 20 through line 12 of column 21, and Fig. 4D); and

outputting the notification message (lines 49-54 of column 20, line 66 of column 20 through line 12 of column 21, and Fig. 4D) for transmission to said at least one addressed recipient (The recitation of “for” accomplishing a function is intended use, indirect, and passive which renders any recitation claimed after not be given patentable weight).

As to claim 2, Luzeski et al. discloses further comprising the steps of:

receiving the media content in a multimedia messaging server (abstract and lines 23-34 of column 2); and

providing the at least one addressed recipient with the media content via the network entity (lines 28-34 of column 15 designates the message destined for multiple recipients and lines 54-55 of column 16);

wherein the network entity is a multimedia messaging relay (lines 22-34 of column 2 and lines 25-45 of column 4).

As to claim 3, Luzeski et al. discloses wherein a streaming session is established (lines 30-48 of column 20, lines 55-65 of column 20, and Fig. 4D) in order to stream at least some of the media content to said at least one recipient (The recitation of “in order to” accomplishing a function is intended use, indirect, and passive which renders any recitation claimed after not be given patentable weight).



As to claim 4, Luzeski et al. discloses wherein said establishing of a streamed session is preceded by transmitting the notification message to said at least one addressed recipient (lines 30-48 of column 20, lines 55-65 of column 20, and Fig. 4D, also lines 27-32 of column 12).

As to claim 5, Luzeski et al. discloses wherein the media content comprises a set of different types of components and each component can be formatted in one or more formats (See column 2, lines 4-34, prior art).

As to claim 6, Luzeski et al. discloses wherein the method further comprises the following steps before said outputting of the media content:

checking the format of at least one component of the received media content (See column 2, lines 4-34, prior art);

determining by using the recipient data whether the format is appropriate for said at least one addressed recipient (See column 4, lines 45-54, also see column 12, lines 5-15, also see column 14, lines 41-65); and

if necessary, translating the component into a format appropriate for said at least one addressed recipient (See column 4, lines 45-54, also see column 12, lines 5-15, also see column 14, lines 41-65).

As to claim 7, Luzeski et al. discloses wherein said notification message provides a minimum amount of information necessary for said at least one addressed recipient to establish a streaming session with the said network entity (See column 18, lines 15-42, also see column 17,

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lines 1-18).

As to claim 8, Luzeski et al. discloses wherein the method further comprises providing a radio link during communication with the addressed recipient (See column 1, lines 45-50, prior art).

As to claim 9, Luzeski et al. discloses wherein said sending entity is chosen from a group consisting of:

a media storing entity of a first telecommunication network, a media storing entity of a second telecommunication network, a media storage in an external data transmission network, and a terminal of the first telecommunication network (lines 51-54 of column 3, lines 29-45 of column 5 and item 10-2 of Fig. 1 --notification server--, lines 46-62 of column 5 and items 12-4 and 12-5, both of Fig. 1 --content server--; items are shown as separate units --messaging platform 10-- and --server (web platform) 12-- in Fig. 1).

As to claim 10, Luzeski et al. discloses wherein the method further comprises transmitting the notification message to said at least one addressed recipient via a first telecommunication network and forming said notification message taking into account the properties of the first telecommunication network (lines 28-34 of column 15 designates the message destined for multiple recipients and lines 54-55 of column 16).

As to claim 14, Luzeski et al. discloses wherein the media content comprises a set of different types of components and each component can be formatted in one or more formats (See column 2, lines 4-34, prior art, also see column 13, lines 18-25).

As to claim 15, Luzeski et al. discloses wherein said properties of the first telecommunications network contain at least one ore more of the following:

the network's multimedia capabilities (See column 18, lines 15-42), the network's traffic condition, and the availability of processing resources in that network (See column 13, lines 49-57).

As to claim 16, Luzeski et al. discloses wherein the receiving of the media content form a sending entity includes forwarding the same, via said network entity to a multimedia messaging server corresponding to a communication system of said network entity (lines 22-34 of column 2 and lines 25-45 of column 4).

As to claim 17, Luzeski et al. discloses receiving the media content in multimedia messaging server corresponding to a communication system of said network entity; and providing the at least one addressed recipient with the media content via the network entity (lines 28-34 of column 15 designates the message destined for multiple recipients and lines 54-55 of column 16), at the recipient's discretion, subsequently to a determination made of compatibility of the addressed recipient to the media content in accordance with the notification

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message received by the recipient (See column 4, lines 45-54, also see column 12, lines 5-15, also see column 14, lines 41-65),

wherein the network entity is multimedia messaging relay (lines 22-34 of column 2 and lines 25-45 of column 4).

As to claim 18, Luzeski et al. discloses wherein the determination of compatibility does not require ongoing accessing of the media content by the addressed recipient (See column 7, lines 17-30).

### ***Response to Arguments***

12. Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074.

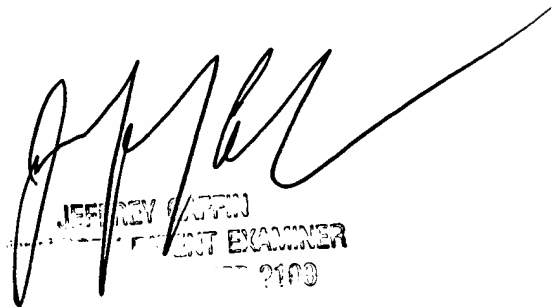
The examiner can normally be reached on 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Neveen Abel-Jalil  
November 13, 2005



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PATENT EXAMINER  
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